



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/227,770	01/08/1999	SURESH NARAYANA CHARI	YO999-002	7725

7590

03/24/2003

IBM CORPORATION
INTELLECTUAL PROPERTY LAW DEPT
P O BOX 218
YORKTOWN HEIGHTS, NY 10598

EXAMINER

JACKSON, JENISE E

ART UNIT

PAPER NUMBER

2131

DATE MAILED: 03/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/227,770

Applicant(s)

CHARI ET AL.

Examiner

Jenise E Jackson

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14-25 and 46-59 is/are allowed.
- 6) ☒ Claim(s) 1,2,4,7-13,26,27,35 and 40 is/are rejected.
- 7) ☒ Claim(s) 3,5,6,28-34,36-39 and 41-45 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 4, 7-13 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claims above recite the limitation of a coprocessor and agent. The specification on page 7, states that given that a certain functionality is intended and expected of the application executing on the secure coprocessor, and external agent can neither subvert nor disrupt the execution of such an application. There is no mention in the specification of an agent embedded at the proxy, there is only support of a coprocessor that is embedded at the proxy. According to claim 1, the coprocessor is used as an agent, but according to the specification it seems as if there is a coprocessor and an agent, but the specification does not disclose the limitations that included an agent performing the functions related to it. Therefore, the claims above are lacking enablement, for not describing in the specification the function of the agent as it relates to the claims. The Examiner asserts is the coprocessor the same as the agent? The Examiner is unsure as it relates to the specification.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 26, 35, 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cashman et al.

Cashman discloses embedding a secure coprocessor(100) for use as an agent of the client(108), and server(107)(see fig. 1, sheet 1, see col. 7, lines 48-65), employing a proxy(i.e. network device)(104) between the client and the server to provide connection links between the client and server(see fig. 1, sheet 1), the coprocessor(100) acting as converter between at least one protocol the client(108) supports and at least one other protocol supported by the server(107), the Examiner asserts that Cashman discloses this because Cashman discloses that the coprocessor(100) can implement protocols on data in both the sending and receiving directions(see col. 8, lines 29-32), and employing respective security protocols of the at least one protocol and the at least one other protocol; the Examiner asserts that security protocol is broadly interpreted to be any protocol that is security related. Therefore, Cashman discloses employing respective security protocols of the at least one protocol and the at least one other protocol, because Cashman discloses that the coprocessor(100) performs protocols such as encryption and decryption(see col. 8, lines 19-20, col. 13, lines 27-29). Further, Cashman discloses splicing a plurality of secure communication protocols of different protocol suites into the agent, because

Art Unit: 2131

Cashman discloses that the coprocessor can be programmed for multiple protocols(see col. 3, lines 44-48, col. 4, lines 39-50).

5. As per claims 2, 27, Cashman discloses wherein the coprocessor(100) is located at the site of the proxy(104)(see fig. 1, sheet 1, col. 7, lines 48-58) .

6. Claims 3, 5-6, 28-34, 36-39, 41-45 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 14-25, 46-59 are allowable for containing a trusted application in a secure coprocessor, Cashman does not disclose this, nor preventing tampering, or n-tuple.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jenise E Jackson whose telephone number is (703) 306-0426. The examiner can normally be reached on M-Th (6:00 a.m. - 3:30 p.m.) alternate Friday's.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gail Hayes can be reached on (703) 305-9711. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-0040 for regular communications and (703) 308-6306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Application/Control Number: 09/227,770

Page 5

Art Unit: 2131

gg

March 18, 2003

Gail Hayes
GAIL HAYES
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100